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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,185	09/29/2003	William T. Donofrio	END 5032	1959
2777 7590 03/26/2007 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER HOEKSTRA, JEFFREY GERBEN	
			ART UNIT	PAPER NUMBER
			3736	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/26/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,185	<b>Applicant(s)</b> DONOFRIO ET AL.	
	<b>Examiner</b> Jeffrey G. Hoekstra	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/2006 has been entered.

### ***Notice of Amendment***

2. In response to the amendment filed on 12/18/2006, amended claim(s) 1 is/are acknowledged. The current rejections of the claim(s) 1-15 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Objections***

4. Claim 2 is objected to because of the following informalities: the positive recitation of " a personalized message" appears duplicate the limitation of "an audio personalized message" recited in independent claim 1 line 3 and may render the claim indefinite. The Examiner notes for the purposes of examination on the merits " a personalized message" was treated as referring in the antecedent to "the audio personalized message" of claim 1. Furthermore, Applicant may have intended the claim to positively recite "the audio personalized message". Appropriate correction is required.

5. Claims 5 and 6 are objected to because of the following informalities: the positive recitation of "the patient's information" appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended the claim to positively recite "a patient's information". Appropriate correction is required.

6. Claims 7-9, 12, 14 and 15 are objected to because of the following informalities: the positive recitation of "the personalized message" appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended the claim to positively recite "the audio personalized message". Appropriate correction is required.

7. Claim 10 is objected to because of the following informalities: the positive recitation of " the request" appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended the claim to positively recite "the audio request". Appropriate correction is required.

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8. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The "audio stimulus" limitation positively recited in claim 10 line 1 is equivalent to the "audio request" positively recited in claim 1 line 2.

9. Claim 11 is objected to because of the following informalities: the positive recitation of " the audio stimulus" appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended the claim to positively recite "the audio request" or "the audio personalized message". Appropriate correction is required.

10. Claim 13 is objected to because of the following informalities: the positive recitation of " the voice or sounds" appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended the claim to positively recite "a voice or sounds". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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12. Claims 1-3, 5, 9, 10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hickle (US Patent No. 6,745,764).

13. For claims 1, 9, and 10, Hickle discloses a conscious sedation system (10) as broadly as *structurally* claimed, comprising:

- a controller (14) which generates an audio request or stimulus (column 21 lines 15-44) via a speaker (450) for a response from a patient (column 23 lines 1-12), the audio request capable of including an audio personalized message (e.g. the inputted patient ID information positively recited in column 11 lines 57-63 and column 28 line 62 – column 29 line 5); and
- a response testing apparatus (256, 264, 266), including:
  - a request or command assembly (256 & 264) which communicates to the patient the audio personalized message generated by the controller, and
  - a response assembly (256 & 254) which detects the response and which communicates the response to the controller.

14. For claims 2, 3, 5, and 12-14, Hickle discloses a conscious sedation system (10) as broadly as *structurally* claimed including, a digital input device (e.g. a keypad, a touch screen, or a remote control, element 230 or 45, or a microphone positively recited in column 17 lines 10-14) used in part by the request assembly to enter the patient's information and that is capable of generating the audio personalized message (e.g. the inputted patient ID information positively recited in column 11 lines 57-63 and column 28 line 62 – column 29 line 5), wherein said audio personalized message is revised manually or automatically (column 29 lines 11-13).

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15. For claims 4 and 6, Hickle discloses a conscious sedation system (10) as broadly as *structurally* claimed including, operational software (column 10 lines 40-41 and column 33 lines 58-60) for the microprocessor that is capable of being test-to-speech software and voice recognition software.

16. For claims 7, 8, 11, and 15, Hickle discloses a conscious sedation system (10) as broadly as *structurally* claimed including, an audio personalized message, as aforementioned, that is capable of being in the most familiar voice (e.g. the patient's voice that is a sound), the doctor's voice, and/or the patient's name.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JH

